

Office Action Summary

Application No.	Applicant(s)	
10/816,635	GREER ET AL.	
Examiner	Art Unit	
Tamra L. Dicus	1774	

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,12,14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,12,14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The prior rejections are withdrawn due to Applicant's amendments.

Claim Objections

Claim 7 is objected to because of the following informalities: "EVA" should be spelled out or if using the abbreviation, it should be in parentheses with the word in front of it.

Appropriate correction is required.

Claim 14 is objected to because of the following informalities: "comprises" should be "has" because the adhesive softening point is a property, not an element. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 (amended) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner believes that independent claim 1 (amended) does not have the proper

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support in the original specification as filed because the specification does not provide any teaching or discussion on a second section being created by a first section or its usage with Applicant's claimed pavement marking. See for example, page 9, last paragraph bridging page 10, and the last complete paragraph found on page 10 (a first section is a separate and independent grid, and a second insert section 12, there is no second insert creating a first section).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear to a second section being created by a first section, especially since the first and second sections are independent as currently claimed (see also instant claims 12 and 16), which makes it further unclear if the first and second sections are within one grid, or if they are separate and independent sections. It is also unclear what sections define a top and bottom surface.

Claim 7 is not clear what an adhesive is sprayable bridging "as a" variety of polymer adhesives means. The term "resin based" or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "resin based"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Further the language "as a" is not an acceptable Markush group listing. One acceptable form of

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alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). Suitable language to include would be {"wherein the X are selected from the group consisting of". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakazawa (US 5,238,721).

Nakazawa teaches claim 1. (Currently amended): A pavement marking pattern comprising: an independent first section (5, FIG. 1 and associated text), an independent and plurality of second sections (6, FIG. 1 and associated text), wherein said second section is an insert affixed via adhesive to said first section and coplanar in relationship to said first and said second section, inherently both first and second sections define a top surface and a bottom surface, said first section contiguous to said second section forming an intersection therebetween (inherent to the structures, see also 8, FIG. 1 and associated text) , and said adhesive, bridging and bonding said intersection (3:1-10, 3:30-45, 4:1-9, synthetic resin paste, embraces thermosetting and thermoplastic adhesive) inherently maintaining integrity of said pavement

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pattern because the same material and elements are employed. Both first and second sections are made by synthetic resins (2:39-44, 3:35-36). Claims 1, 3-6, 12, and 16 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazawa (US 5,238,721) in view of Scharpf (US 5509715).

Nakazawa essentially teaches the claimed invention above.

Nakazawa does not expressly refer to the synthetic resin adhesives as thermosetting, thermoplastic, hot melt, or of the recited adhesives as per instant claim 7.

Scharpf teaches a flooring using adhesives for bonding purposes including thermosetting, thermoplastic, hot melt, and ethylene vinyl acetate (EVA) adhesives (6:24-45).

It would have been obvious to one having ordinary skill in the art to have modified the pavement marking of Nakazawa to include the adhesives as claimed because Scharpf teaches all the adhesives are suitable for bonding purposes in flooring or planks (3:25-35, 4:15-30, 6:24-462, Abstract, Scharpf).

To claim 14, because the same materials are employed, the softening point property is inherently expected.

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Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

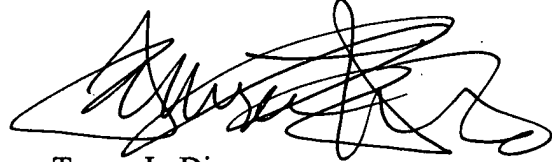
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

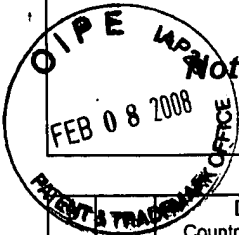
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Tamra L. Dicus', with a large, stylized flourish at the end.

Tamra L. Dicus
Examiner
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July 23, 2007



Notice of References Cited

Application/Control No. 10/816,635		Applicant(s)/Patent Under Reexamination GREER ET AL.	
Examiner Tamra L. Dicus		Art Unit 1774	Page 1 of 1

U.S. PATENT DOCUMENTS

		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-5,509,715	04-1996	Scharpf, Mike A.	52/408
*	B	US-5,238,721	08-1993	Nakazawa, Masahiro	428/44
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.